Doc Code: AP.PRE.REQ

PTO/SB/33 (01-09)
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# PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
02316.1220USD1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

| Application Number | Filed |
|---|---|
| 10/685,770 | 10/14/2003 |

First Named Inventor: Thomas W. Kampf

| Art Unit | Examiner |
|---|---|
| 3726 | Omgba, Essama |

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 50,471
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

/Robert A. Kalinsky/
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Typed or printed name

612.336.4771
Telephone number

02-18-2009
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | | |
|---|---|---|---|
| Applicant: | Kampf et al. | Examiner: | Essama Omgba |
| Serial No.: | 10/685,770 | Group Art Unit: | 3726 |
| Filed: | October 14, 2003 | Docket No.: | 02316.1220USD1 |
| Customer No.: | 23552 | Confirmation No.: | 6337 |
| Title: | Cable Trough Method with Separate Side Elements | | |

**ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

This is in support of the Pre-Appeal Brief Request for Review that is filed herewith. Reconsideration and allowance are requested for at least the following reasons.

I. Rejection

In the final Office Action mailed September 3, 2008, claims 1-6 are rejected under 35 U.S.C. § 102(b) as being anticipated by Miranda (U.S. Patent No. 6,107,575). Claims 1-6 are, in the alternative, rejected under 35 U.S.C. § 103(a) as being unpatentable over Bernard in view of Miranda. Applicants respectfully traverse the rejections. Reconsideration is requested for at least the following reasons.

For purposes of brevity, only arguments directed to claim 1 of the present application are provided herein. A similar analysis can be applied to claims 3 and 5 of the present application.

II. Statutes, Laws, and Rules

To anticipate, a reference must teach each and every claim limitation. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP 2131. To render obvious, one or more references must teach every claim limitation. 35 U.S.C. 103(a); MPEP 2141. References cannot be combined when one reference teaches away from the suggested combination. See KSR Int'l v. Teleflex Inc., 127 S. Ct. 1727, 1740 (citing United States v. Adams, 383 U.S. 39, 50-51, 86 S. Ct. 708 (1966)); MPEP 2143.01 and 2145(X)(D)(2).

III. Claim Language

Claim 1 recites the following.

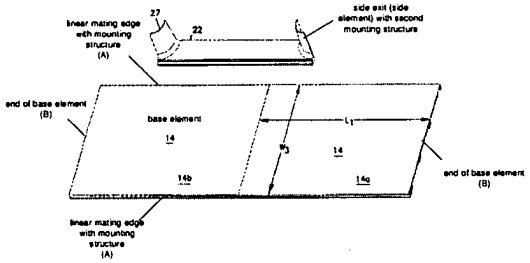
1. (Previously Presented) A method of assembling a cable routing system comprising the steps of:

providing a base element with a planar top surface, the top surface having a linear mating edge on opposite sides of the planar top surface, each linear mating edge having a continuous cross-section along the length of each linear mating edge, and each linear mating edge defining a first mounting structure;

mounting a plurality of side elements to the base element along the linear mating edges by attaching second mounting structures formed on the side elements with the first mounting structure of the respective linear mating edge, the first and second mounting structures being connected to couple the side elements to the base element, a first plurality of the side elements having an upstanding wall portion extending to a vertical height above the planar top surface of the base element, a second plurality of the side elements defining side exits extending transversely relative to the linear mating edges, and generally parallel to the planar top surface; and

mounting the base element at a vertical height above a telecommunications bay.

One example of a base element and side element configured in the manner recited in claim 1 is shown below.




Application, Fig. 2 (annotations added). As shown in Figure 2, the base element includes linear mating edges (see "A") having a continuous cross-section and defining a first mounting structure. Forming the linear mating edges "A" with a continuous cross-section is advantageous because it allows the base elements to be manufactured by extrusion. This is in contrast to the ends "B" of the base elements, which do not have a continuous cross-section. Also, the side exit includes a second mounting structure that allows the side exit to be coupled to the base element in a generally parallel manner.

## IV. Analysis

### A. Claim Rejections – 35 U.S.C. § 102

The final Action concedes that Miranda fails to disclose the method recited by claim 1. For example, the Action concedes that Miranda fails to disclose or suggest a second plurality of

the side elements defining side exits extending transversely relative to the linear mating edges, and generally parallel to the planar top surface. As such, Miranda fails to anticipate claim 1.

B. Claim Rejections – 35 U.S.C. § 103

The final Action concedes that Bernard fails to disclose or suggest a base element and a plurality of side elements mounted thereto. Instead, the Action states that it would have been obvious to form the cable routing system disclosed by Bernard from separate elements as taught by Miranda. This statement is respectfully traversed for at least the following reasons.

i. The Purported Combination Does Not Arrive at the Claimed Inventions

The Advisory Action mailed December 18, 2008 states the following.

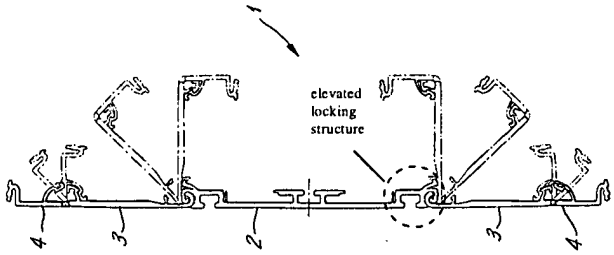
> The examiner maintains that one of ordinary skill in the art would know how to incorporate such [a] side exit [of Bernard] between two sections of the duct system of Miranda by way of a duct coupler...

Advisory Action, p. 4, ll. 5-8. This purported combination would apparently require that two longitudinal channels of Miranda are connected by an intermediate side exit fitting of Bernard using a coupler. Such a combination, if it could be made, would not arrive at the claimed inventions.

Claim 1 requires that the linear mating edges of the base element have a continuous cross-section. Therefore, only the sides of the element extending in the longitudinal direction qualify as the linear mating edges, since only the sides that have a continuous cross-section. See the annotated figure printed above.

In contrast, the Advisory Action suggests connecting the ends of two longitudinal sections of the channel disclosed by Miranda with a coupler and side exit fitting disclosed by Bernard. Such a combination would not result in the claimed inventions, since the ends of the channels disclosed by Miranda do not have continuous cross-sections, as required by claim 1.

Further, if the side elements 3 of Miranda could be coupled to the fittings shown in Figures 10 and 12 of Bernard, the locking structure of the element 2 of Miranda would be required, as shown in Figure 3 of Miranda. This locking structure is elevated with respect to the top surface of the element 2, as shown in Figure 1 of Miranda, reprinted below (annotations added).




This elevation of the locking structure of Miranda would not allow side exits to extend transversely relative to the linear mating edges, and generally parallel to the planar top surface, as required by claim 1.

As such, the purported combination of Miranda with Bernard does not teach all of the limitations of claim 1.

ii. The References Teach Away from the Purported Combination

Bernard teaches away from the purported combination with Miranda because Bernard states the following:

> The coupler 100 has an inner wall consisting of two side walls 110 and a bottom wall 120, which are preferably integral and continuous.

Bernard, col. 3, ll. 5-7 (underling added). Bernard therefore requires couplers and troughs with integral walls and teaches away from forming a base element and a plurality of side elements mounted thereto. Bernard cannot be combined with Miranda.

iii. The References Cannot be Combined as Suggested

Miranda discloses a linear channel section with pivotable wall elements. In contrast, the elements of Figures 10 and 12 of Bernard that are identified in the Action are fittings. Such fittings are typically attached to the ends of linear sections. See, for example, Fig. 1 of U.S. Patent No. 6,739,795, which shows a linear trough 12 coupled to a fitting 18 by a coupler 14.

There is no suggestion provided as to how one would take the fittings disclosed by Bernard and incorporate the linear sections disclosed by Miranda to arrive at the claimed inventions. For example, the Action fails to identify how the fittings disclosed in Figures 10 and

12 of Bernard could be coupled to the longitudinal sides of the element 2 of Miranda. Such a combination, as suggested in the Action, could not be made.

iv. There is No Suggestion to Make the Purported Combination

In addition, there is no suggestion as to how or why one skilled in the art would be motivated to modify the fittings disclosed by Bernard based on the channels disclosed by Miranda to arrive at the claimed methods. Claims 1-6 do not simply recite methods that include breaking a cable routing system into various elements, but instead recite specific structures for each of the elements that allow the elements to be assembled according to the steps of the claimed methods. Neither Bernard nor Miranda, alone or in combination, discloses or suggests assembly methods for cable routing systems as recited in claims 1-6. Further, even if the fittings disclosed by Bernard could be broken into separate elements, there are literally thousands of different ways in which the elements could be formed. It is therefore respectfully suggested that it would not have been obvious to try because there are not simply a finite number of identified, predictable solutions.

V. Conclusion

Favorable reconsideration in the form of a Notice of Allowance is respectfully requested. Please contact the undersigned attorney with any questions regarding this application. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 13-2725.

Respectfully submitted,
MERCHANT & GOULD P.C.

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Date: February 18, 2009

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